

REMARKS

In the Office action, claims 1-20 were subject to a restriction requirement. It was alleged that the claims were directed to three distinct inventions grouped as follows:

- Group I-Claims 1-7
- Group II-Claims 8-15; and
- Group III-Claims 16-20.

In response to the restriction requirement, Applicants respectfully elect Group I with traverse. Specifically, Applicants traverse the restriction between Groups I and II based upon the amendment to claim 8. Specifically, claim 8 has been amended so as to be a linking claim. To summarize the law, "[t]here are a number of situations . . . in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the application to one would be proper, but presented in the same case are one or more claims (generically called "linking" claims) inseparable therefrom and thus linking together the inventions otherwise divisible." (MPEP § 809.03)(emphasis added). A common type of linking claim includes a means for practicing a process linking proper apparatus and process claims. (See id.).

In the present case, claim 8 has been amended so as to define an apparatus that includes means for performing the steps of the method recited in claim 1. As such, it is a linking claim and no longer proper to restrict claim 8 and, therefore, Group II from Group I.

In addition, Applicants traverse the restriction between Groups I and III based upon the non-allowance of the linking claim introduced by the present amendment. Based upon the presence of this linking claim Applicants respectfully contend that should the same be deemed allowable, then the restriction requirement would be improper and the requirement restricting the claims of Groups I and III would have to be withdrawn (See MPEP 818.03(d)).

Applicants contend that claim 8 links the process claims in Group I with the apparatus of claims in Group III. As such, the claims of Group III would not be divisible from those of Group I were the linking claim, present in Group II, found to be allowable. See MPEP section 806.04(a). Therefore, as claim 8 links the claims of both Groups I and III, Applicants

respectfully contend that the restriction requirement would be improper and that the same be withdrawn upon the allowance of claim 8.

Finally, Applicants respectfully contend that the restriction of the claims included in Group III was improper pursuant to MPEP sections 806.05(e) and 2106. In those sections it states that "[i]n applications claiming inventions in different statutory categories, only one-way distinctiveness is generally needed to support a restriction requirement. (See MPEP § 806.05(e)). Specifically, were it shown "(1) that the process *as claimed* can be practiced by another materially different apparatus or by hand, or (2) that the apparatus *as claimed* can be used to practice another materially different process", then restriction is proper. (See *id.*, emphasis in the original). However, pursuant to MPEP section 2106, were an apparatus claim to encompass "any and every computer implementation of a process, when read in light of the specification, the claim should be examined on the basis of the underlying process." (See MPEP § 2101, emphasis in the original). That section continues with an example of such an apparatus claim. Such a claim will:

"(A) define the physical characteristics of a computer or computer component exclusively as functions or steps to be performed on or by a computer, and

(B) encompass any and every product in the state class (e.g., computer, computer-readable memory) configured in any manner to perform that process."

Section 2106 continues, on page 2100-14 of the MPEP, to describe the subject matter that must be recited in the patent specification. Specifically, "[t]he disclosure [should state] . . . that it would be a matter of routine skills to select an appropriate conventional computer system and implement the claimed process on that computer system. The disclosure does not have specific disclosure that correspond to the two "means" limitation recited in the claim (i.e., no specific software or logic circuit)."

In the instant application, the claims included in Group III define physical characteristics of computer components as functions performed by a computer. In addition, the specification does not include specific software, i.e., programming code recited to define the aforementioned functions. Rather, in the text bridging page 11, lines 10-21, it is stated that computer code executed by a processor may be written in any conventional computer readable programming language such as, for example, 68000 assembly language, C, C++, Pascal,

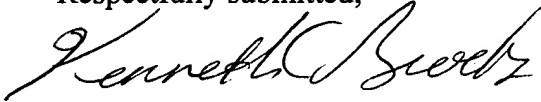
Fortran, or other language. The aforementioned text indicates that it would be a matter of routine skill to select an appropriate conventional computer system and implement the claimed process on the computer system. Thus, the apparatus defined by the claims included in Group III encompasses any and every product in the class (e.g., computer, computer-readable memory) configured in any manner to perform the process defined by the claims included in Group I. As a result, the claims included in Group III should be rejoined with the Claims of Group I and stand or fall together, i.e., the patentability the apparatus claim stands or falls and depends upon the patentability of the process claims included in Group I. (See MPEP § 2106). Applicants respectfully contend that, based upon the foregoing, it was improper to restrict the claims of Group III from the claims in the remaining groups. Therefore, Applicants respectfully request that the claims included in Group III be rejoined in the present application.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,



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